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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Buell Andrew Pratt

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INTELLECTUAL PROPERTY DEPARTMENT

SANTA MONICA, CA 90404

EXAMINER

LEE, JOHN W

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/766,700	<b>Applicant(s)</b> PRATT ET AL.	
	<b>Examiner</b> JOHN Wahnkyo LEE	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The response received on 24 April 2008 has been placed in the file and was considered by the examiner. An action on the merits follows.

#### ***Response to Arguments***

2. Applicant's arguments filed 13 March 2008 have been fully considered but they are not persuasive.

#### **§ 101 Rejections**

Applicant's arguments with respect to claims 27-37 are rejected under 35 U.S.C. §101 have been considered, but are not persuasive. The claims 27-37 are not about transforming an article or physical object to a different state or thing. Claims 27-37 is just claiming an archive, which is just a collection of paper. Therefore, the rejection to claims 27-37 under 35 USC §101 will not be withdrawn.

#### **§ 112 Rejection**

Because the applicant had amended claim 37, rejection of claim 37 under 35 USC §112 will be withdrawn.

#### **§ 102 & 103 Rejections**

.The applicant argues that Reber fails to disclose a roll of spliced together Media Assets. The examiner does not agree with the applicant. If the applicant had recited that an archive of a plurality of media segments are physically spiced together and wound to

form a roll, then the applicant's argument can be right. However, the claims does not recite that the roll was formed by winding the plurality of media segments physically. So, creating a digital archive by linking or binding a digitized representation of the media disclosed by Reber can read on a roll of spliced together Media Assets.

The applicant argues that Reber fails to disclose a condensed Roll of Spliced together Media Assets. The "condensed" roll of spliced together Media Assets is not recited in the claim 27. It seems the applicant arguments are based on the specification of the application. The examiner only reviews the claim based on its claim languages itself without reading the specification on it.

The detail rejection will be provided below including the new added claim.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 27-37 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized.”

Claims 27-37, while defining an archive, does not define a “computer-readable medium” and is thus non-statutory for that reasons. An archive can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” - MPEP 2106.IV.B.1(a)

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Regarding claim 37, the phrase “such as” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). In claim 37, the applicant uses the phrase, “such that” which can be equivalent to “such as.”

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims rejected under 35 U.S.C. 102(e) as being anticipated by Reber et al. (US 6,636,869).

Regarding claim 27, Reber discloses an archive (abstract, "media data") of a plurality of media segments (abstract, "piece of media") from a motion picture (Fig. 1, "VTR'S & OTHER Media SOURCES") comprising:

a roll formed by winding (Fig. 1; col. 3, lines 48-50, "VTRs") the plurality of media segments (col. 1, lines 42-58, "clips"), each segment spliced to another of the segments, wherein each segment has a location within said roll and a first information (claim 7, ".. originates ..."); and a database (Fig. 1, "Media Database"; claim 7) having a record for each segment associating the location of the segment within said roll, with said first information (claim 7); whereby said database provides said first information and the associated location in said roll of the plurality of media segments (claim 7); and whereby the physical volume required to store said plurality of media segments is reduced and the accessibility of said plurality of media segments is maintained (Fig. 1, "digitizing"; col. 3, lines 48-55, "It is inherent that if the VTR's data is digitized and stored on a hard disk drive, then the segments will be reduced and it will maintain or increase the accessibility of the data via computer").

Regarding claim 28, Reber discloses that the first information is comprised of at least one of a key number associated with a first end of the segment, a splice designation, and a note labeling the segment (abstract, "labels").

Regarding claim 29, Reber discloses that wherein one of the segments has a frame, said frame having a second information and a location in said roll (claim 7); said database further having a record associating the location of said frame with said second information; whereby said database provides said second information and the location in said roll associated with the frame (claim 7, “a time range ...”).

Regarding claim 30, Reber discloses that the consolidated archive of claim 29, wherein said second information comprises at least one of a key number, a slate record, a flash frame designation, and a wave designation (col. 8, lines 33-44, “unique identifier”).

Regarding claim 31, Reber discloses further comprising: a digitized media file of said plurality of file segments ((Fig. 1, “digitizing”; col. 3, lines 48-55), said media file having a substantial correspondence to said roll (claim 7); whereby said database, from the location in said roll of said frame, identifies a portion of said media file substantially representative of said frame (claims 15-18).

Regarding claim 32, Reber discloses further comprising: a digitized media file of said plurality of file segments ((Fig. 1, “digitizing”; col. 3, lines 48-55), said media file having a substantial correspondence to said roll (claim 7); whereby said database, from the location in said roll of said frame, identifies a portion of said media file substantially representative of said frame (claims 15-18).

Regarding claim 33, Reber discloses that wherein one of the segments has a frame (claim 7), said frame having a second information and a location in said roll (claim 7); said database further having a record associating the location of said frame with said

second information (claim 7); whereby said database provides said second information and the location in said roll associated with the frame (claim 7); and whereby said database, from the location in said roll of said frame, identifies a portion of said media-file substantially representative of said frame (claims 15-18).

Regarding claim 34, Reber discloses further comprising: a client (col. 4, line 50); a media server having access to said media file (Fig. 1, col. 4, lines 26-67; col. 5, lines 1-10); and a network (Fig. 1, col. 4, lines 26-67; col. 5, lines 1-10); said network connecting said client to both said database and said media server (Fig. 1, col. 4, lines 26-67; col. 5, lines 1-10); thereby providing said client with communication to both said database and said media server (Fig. 1, col. 4, lines 26-67; col. 5, lines 1-10); at least one of said database and said client further having a means for selecting from the media server a portion of the media file to be provided to the client (col. 4, lines 50-53); said client comprising a means for searching the database (col. 4, lines 50-53); a means for displaying results provided by the database (claims 58 and 170); and a means for displaying the portion of the media file provided by the media server (claims 58 and 170); whereby the accessibility of said plurality of media segments is increased (col. 4, lines 50-53).

Regarding claim 36, Reber discloses that wherein said media file is suitable for use by a non-linear editing station (col. 1, lines 42-65).

Regarding claim 37, Reber discloses wherein the client further comprises: a first means for indicating to said database a portion of said roll and a format for delivery (col. 4, lines 25-67; col. 5, lines 1-10); said database responsive to said first means,



such that an order is generated to prepare said portion of said roll according to the format; whereby a user of the client can order the media segments from the consolidated archive (col. 4, lines 25-67; col. 5, lines 1-10).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 6,636,869) in view of Hoffert et al. (US 2001/0014891).

Regarding claim 35, Reber discloses all the previous claim limitations except the one recited in claim 35. However, Hoffert discloses that said media file is streaming media (paragraph [0082]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Hoffert's invention in Reber's invention to provide dynamic linking or binding as suggested by Reber (col. 2, lines 45-46).

10. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 6,636,869).

Reber discloses a storage device for reducing the physical storage volume of a plurality of physical media segments from a motion picture comprising (col. 2, lines 62-

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67, "physical source mediums ..."): a wound roll (Fig. 1; col. 3, lines 48-50, "VTRs") of the plurality of physical media segments, each segment being physically spliced to another of the segments (col. 1, lines 42-58, "clips"); each of the plurality of physical media segments has a location within the roll and a first information (claim 7, "... originates ..."); and a computerized database (Fig. 1, "Media Database"; claim 7) having a record for each segment associating the location of the segment within said roll, with said first information (claim 7); whereby said database provides said first information and the associated location in said roll of the plurality of physical media segments (claim 7); and whereby the physical volume required to store said plurality of media segments is reduced while maintaining accessibility each of said plurality of physical media segments (Fig. 1, "digitizing"; col. 3, lines 48-55, "It is inherent that if the VTR's data is digitized and stored on a hard disk drive, then the segments will be reduced and it will maintain or increase the accessibility of the data via computer"). However, a physical storage volume occupied by the wound roll of the plurality of physical media segments being less than the physical storage volume required for the plurality of physical media segments when unwound and not spliced together is not disclosed by Reber, but it is widely and well-known fact by one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Reber's invention to implements the features disclosed in claim 38.

***Conclusion***

11. No claims are allowed.
12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN Wahnkyo LEE whose telephone number is (571)272-9554. The examiner can normally be reached on Monday - Friday (Alt.) 7:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jingge Wu/

Supervisory Patent Examiner, Art Unit 2624

/John Wahnkyo Lee/

Examiner, Art Unit 2624

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